UNITED STATES PATENT AND TRADEMARK OFFICE

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EXAMINER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

	Application No.	Applicant(s)
Office Action Summary	10/654,733	WILLIAMS, EMRYS J.
	Examiner	**Art Unit**	
	Charlie C. Agwumezie	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS,
WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>02 July 2007</u>.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1,2,4-10,12-31,33-37 and 39</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-2, 4-10, 12-31, 33-37 and 39</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date <u>12/22/03</u>.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____ .

DETAILED ACTION

Status of Claims

1.   Claims 3, 11, 32, and 38 are cancelled. Claims 1, 4, 5, 7, 9, 12-13, 15, 17, 25,

30, 36 and 39 are amended. Claims 1-2, 4-10, 12-31, 33-37 and 39 are pending in this

application per the response to office action filed on July 2, 2007.

Response to Arguments

2.   Applicant's arguments with respect to claims **1-2, 4-10, 12-31, 33-37 and 39**

have been considered but are moot in view of the new ground(s) of rejection.

Specification

3.   The specification is objected to as failing to provide proper antecedent basis for

the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction

of the following is required:

     a.   "means for storing a set of multiple identifier..." as recited in claim 15

     b.   "means for selecting, for each of the plurality of transactions..." as recited

in claim 15.

     c.   "means for, creating, a respective transaction record..." ...as recited in

claim 15

     d.   "means for, storing a plurality of customer account records..." as recited in

claim 39.

e.   "means for mapping identifier to corresponding account record..." as

recited in claim 39

f.   "means for accessing an identifier..." as recited in claim 39.

g.   "means for accessing digital signature..." as recited in claim 39

h.   "means for updating the customer account..." as recited in claim 39

Claim Rejections - 35 USC § 112

4.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

In **claim 15**, it unclear what is the corresponding structure (and the equivalents

thereof) of the

a.   "means for storing a set of multiple identifier..." as recited in claim 15

b.   "means for selecting, for each of the plurality of transactions..." as recited

in claim 15.

c.   "means for, creating, a respective transaction record..." ...as recited in

claim 15

In **claim 39**, it unclear what is the corresponding structure (and the equivalents

thereof) of the

d.   "means for, storing a plurality of customer account records..." as recited in

claim 39.

e.   "means for mapping identifier to corresponding account record..." as

recited in claim 39

f.   "means for accessing an identifier..." as recited in claim 39.

g.   "means for accessing digital signature..." as recited in claim 39

h.   "means for updating the customer account..." as recited in claim 39

Regarding all the means for" phrases, Applicant is again reminded, "For claim clauses containing functional limitation in 'means for' terms pursuant to § 112 ¶ 6, the claimed function and its supporting structure in the specification must be presented with sufficient particularity to satisfy the requirements of § 112 ¶ 2." *S3 Inc. v. nVIDIA corp.,* 259 F.3d 1364, 1367, 59USPQ2d 1745, 1747 (Fed. Cir. 2001) (citations omitted). In other words, "[f]ailure to describe adequately the necessary structure, material, or acts corresponding to a means-plus-function limitation in the written description means that the drafter has failed to comply with Section 112, Para. 2." *Atmel Corp. v. Information Storage Devices, Inc.,* 198 F.3d 1374, 1380 53USPQ2d 1225, 1229 (Fed. Cir. 1999) *citing In re Dossel,* 115 F.3d 942, 945, 42 USPQ2d 1881, 1884 (Fed. Cir. 1997).

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-2, 4-8, 9-14, 16, 26, and 28-29, are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al U.S. Patent Application Publication No. 2006/0218098 A1 in view of Wynn Patent No. US RE38,137 E.

As per **claims 1, 9, and 16**, Walker et al discloses an Apparatus for use in transactions, comprising:

non-volatile memory containing a set of multiple identifiers associated with a same customer account, wherein said multiple identifiers are also known to an agency providing said customer account (fig. 1; 0025; 0026; "...plurality of predetermined single-use financial account identifiers..."), and

a processor operable to select for each of a plurality of transactions involving the same customer account, a different identifier from said set of multiple identifiers for use with the respective transaction (fig. 1; 0023; 0047; 0049; "...the encryption data changes for each use of the card so that ... card number is different for each transaction...") and

a communications facility operable to communicate with a terminal (0004; ...wireless connection...; 0047; cardholder transmits the single use number to merchant...;);

generate a transaction record from the bill details (0022; ...including transaction specific data...), and

transmit the transaction record to the terminal through the communications

facility (figs. 3 and 4; 0045; 0047; "...transmits the single use number to the

merchant...").

What Walker et al does not explicitly disclose is:

wherein the apparatus is operable to:

receive bill details for a transaction from the terminal through the communications

facility,

Wynn discloses an apparatus for use in transaction comprising:

wherein the apparatus is operable to:

receive bill details for a transaction from the terminal through the communications

facility (fig. 6; col. 2, lines 25-35, 40-50; ...financial transaction data communicated

between UFDC and a card reader...)

Accordingly it would have been obvious to one of ordinary skill in the art at time

of applicant's invention to modify the method of Walker et al and incorporate the

apparatus, wherein the apparatus is operable to: receive bill details for a transaction

from the terminal through the communications facility in view of the teachings of Wynn,

because such will ensure transaction record tracking.

As per **claim 2, and 10**, Walker et al further discloses the apparatus, wherein

each of the identifiers in said set of multiple identifiers is allocated by the agency

uniquely to the apparatus (figs. 1 and 10; 0049; 0093; "...instructing card holder to

obtain a new device with list of single-use credit card numbers...").

As per **claim 4 and 12**, Walker et al further discloses the apparatus, wherein the

transaction record includes a digital signature that is generated using a cryptographic

key contained within the non-volatile memory (0023; 0042; 0065; 0066).

As per **claim 5 and 13**, Walker et al further discloses the apparatus, wherein

the transaction record is encrypted (0009; 0023).

As per **claim 7**, Walker et al further discloses the apparatus, wherein said

apparatus is operable to engage a first class of terminals external to the apparatus for

making a transaction, and a second class of terminals external to the apparatus to enter

or to update account information stored in the non-volatile memory (fig. 3 and 4; 0093).

As per **claim 14**, Walker et al further discloses the method, further comprising

limiting the transaction rate of the device to prevent rapid read-out of the identifiers

(0046).

As per **claim 26**, Walker et al discloses a method for performing a transaction at

a terminal using a portable transaction device, comprising:

generating a bill for the transaction at the terminal (0045; 0097; "...cardholder

uses device to generate transaction specific data..."),

engaging the portable transaction device with the terminal (figs. 3 and 4; 0047),

transmitting the bill from the terminal to the transaction device;

selecting for each of a plurality of transactions involving a same customer

account, a different identifier from a set of multiple identifiers stored on the transaction

device for use in the transaction (fig. 1; 0023; 0047; 0049; "...the encryption data

changes for each use of the card so that ... card number is different for each

transaction..."),

generating a transaction record on the transaction device, the transaction record

incorporating information from the bill and the selected identifier (0045; ...uses device to

generate transaction specific data...), and

transmitting the transaction record to the terminal (figs. 3 and 4; 0045; 0047;

"...transmits the single use number to the merchant...")

What Walker et al does not explicitly disclose is:

transmitting the bill from the terminal to the transaction device. Walker's device

however generates transaction specific data.

Wynn discloses an apparatus for use in transaction comprising:

transmitting the bill from the terminal to the transaction device (fig. 6; col. 2, lines

25-35, 40-50; ...financial transaction data communicated between UFDC and a card

reader...).

Accordingly it would have been obvious to one of ordinary skill in the art at time

of applicant's invention to modify the method of Walker et al and incorporate the

apparatus, wherein the apparatus is transmitting the bill from the terminal to the

transaction device in view of the teachings of Wynn, because such will ensure

transaction record tracking.

As per **claim 28**, Walker et al further discloses the method, wherein the

transaction device is associated with a customer account, and wherein said multiple

identifiers are also known to an agency providing said customer account, the method

further comprising:

transmitting the transaction record from the terminal to an agency computer

(0047; "...merchant enters the single use number into authorization terminal connected

to a central credit card processing system..."),

accessing an account record for the customer account based on the selected

identifier included in the transaction record (0047; "...central system processor

maps...card number onto conventional credit card account..."),

validating the transaction (0047; "...determines whether the transaction is

authorized..."), and

updating the account record in respect of the validated transaction (0093;

"...updated to change the status of the number from not used to used...").

As per **claim 29**, Walker further discloses the method, wherein prior to

transmitting the transaction record from the terminal to the agency computer, the

terminal incorporates its own copy of the bill into the transaction record (0045; 0047).

6.   **Claims 15, 17-25, 30-31, and 33-35, 36-37 and 39,** are rejected under 35 U.S.C.

103(a) as being unpatentable over Walker et al U.S. Patent Application Publication No.

2006/0218098 A1 in view of Sarcanin U.S. Patent No. 2005/0246292 A1.

As per **claims 15 and 17**, Walker et al discloses a method comprising:

opening an account record in an agency computer system, wherein said agency

is to provide the account (fig. 10; 0047; 0093; "…instructing cardholder to obtain a new

device with a new list of single use credit card umbers…"),

generating a set of multiple identifiers to be used for transactions on the account

(0049; 0093),

storing the set of multiple identifiers in the agency computer system (0093;

0097), and

storing the set of multiple identifiers on a portable transaction device (fig. 10;

0093; 0097);

receiving a public key from the portable transaction device (0009; 0023).

What Walker et al does not explicitly disclose is:

receiving a transaction record comprising a digital signature from the portable

transaction device, and

decrypting and validating the digital signature with the public key.

Sarcanin discloses

receiving a transaction record comprising a digital signature from the portable

transaction device (0027; signature being generated .. using the smart card

information...), and

decrypting and validating the digital signature with the public key (0095;

...validate security cards and to provide a unique digital signature...).

Accordingly it would have been obvious to one of ordinary skill in the art at time

of applicant's invention to modify the method of Walker et al and incorporate the

method, wherein receiving a transaction record comprising a digital signature from the

portable transaction device, and decrypting and validating the digital signature with the

public key in view of the teachings of Sarcanin, because such will ensure adequate

transaction security.

As per **claim 18**, Walker further discloses the method, wherein the identifiers are

unique to the account for the agency (0046; "...the number is unique for the specific

input variable...").

As per **claim 19**, Walker et al further discloses the method further comprising

adding the identifiers to an index, wherein said index maps from an identifier to the

corresponding account (0047; 0097; "...transmitted credit card number matches listed in

the credit card database...").

As per **claim 21**, Walker et al discloses the method wherein the identifier within

said set of multiple identifiers are unrelated to one another (0046)

As per **claim 22**, Walker et al further discloses the method, wherein the identifiers are generated on the agency computer system, and are transmitted to the portable transaction device for storage thereon (fig. 10, 0047; 0093).

As per **claim 23**, Walker et al further discloses the method, further comprising generating at least one cryptographic key for use with the account (fig. 1).

As per **claim 25**, Walker et al further discloses the method, further comprising establishing an identity of a person who is to hold the account prior to opening the account (fig. 10; 0097).

As per **claim 30**, Walker et al further discloses a method of operating a computer account system at an agency, said agency maintaining a plurality of customer accounts on the computer account system, wherein each customer account has a set of multiple identifiers associated therewith, the method comprising:

receiving a request for a transaction on a customer account (0045; 0047),

wherein the request comprises a digital signature generated by a transaction device associated with the customer account;

verifying the digital signature;

accessing an identifier within the request (0047),

determining which set of multiple identifiers the accessed identifier belongs to,

and from this determining a customer account for the transaction (0047), and

updating the determined customer account in respect of the transaction (0093).

What Walker does not explicitly disclose is:

wherein the request comprises a digital signature generated by a transaction

device associated with the customer account;

verifying the digital signature;

Sarcanin discloses

wherein the request comprises a digital signature generated by a transaction

device associated with the customer account (0027; signature being generated .. using

the smart card information...);

verifying the digital signature (0095; ...validate security cards and to provide a

unique digital signature...);

Accordingly it would have been obvious to one of ordinary skill in the art at time

of applicant's invention to modify the method of Walker et al and incorporate the

method, wherein receiving a transaction record comprising a digital signature from the

portable transaction device, and decrypting and validating the digital signature with the

public key in view of the teachings of Sarcanin, because such will ensure adequate

transaction security.

As per **claim 31**, Walker et al further discloses the method, wherein determining

which set of multiple identifiers the accessed identifier belongs to comprises accessing

an index that maps identifiers to corresponding account records (0047; "...central

system processor maps...card number onto conventional credit card account...").

As per **claim 33**, Walker et al further discloses the method, further comprising

opening a new customer account by: creating a new account record for the new

customer account (fig. 10; 0093), and

storing a set of multiple identifiers associated with the new customer account into

the new account record (fig. 10; 0093).

As per **claim 34**, Walker et al further discloses the method, further comprising:

generating the set of multiple identifiers associated with the new customer

account (fig. 10; 0093), and

transmitting the generated set of multiple identifiers to a customer transaction

device for use with the new customer account (fig. 10; 0093).

As per **claim 35**, Walker et al further discloses the method, further comprising

generating at least one cryptographic key for use in communications between the

computer account system and the customer transaction device (fig. 1).

As per **claims 36 and 39**, Walker et al discloses a computer account system at

an agency, said system comprising:

a plurality of customer account records, wherein each customer account record

incorporates a set of multiple identifiers associated therewith (fig. 1; 0025; 0026;

"...plurality of predetermined single-use financial account identifiers..."), and

an index that maps identifiers to corresponding account records (0047; "...central

system processor maps...card number onto conventional credit card account..."),

wherein the system is configured to:

receive a request for a transaction on a customer account, wherein the request

comprises a digital signature generated by the transaction device associated with the

customer account;

access an identifier within the request in order to determine which set of multiple

identifiers and hence which customer account the accessed identifier belongs to (0047;

"...central system processor maps...card number onto conventional credit card

account...") and

access the digital signature within the request and use a cryptographic key to

validate the digital signature.

What Walker does not explicitly disclose is:

wherein the request comprises a digital signature generated by the transaction

device associated with the customer account;

access the digital signature within the request and use a cryptographic key to

validate the digital signature.

Sarcanin discloses:

wherein the request comprises a digital signature generated by the transaction

device associated with the customer account (0027; signature being generated .. using

the smart card information...);

access the digital signature within the request and use a cryptographic key to

validate the digital signature (0095; ...validate security cards and to provide a unique

digital signature...).

Accordingly it would have been obvious to one of ordinary skill in the art at time

of applicant's invention to modify the method of Walker et al and incorporate the

method, wherein the request comprises a digital signature generated by the transaction

device associated with the customer account; access the digital signature within the

request and use a cryptographic key to validate the digital signature in view of the

teachings of Sarcanin, because such will ensure adequate transaction security.

As per **claim 37**, Walker et al further discloses the system, wherein the multiple

identifiers associated with a customer account record are unique to that account record

(0046; "...the number is unique for the specific input variable...").

7.   **Claims 6,** is rejected under 35 U.S.C. 103(a) as being unpatentable over Walker

et at U.S. Patent Application Publication No. 2006/0218098 A1 in view of Mann, III et al

U.S. Patent Application Publication No 2006/0122943 A1.

As per **claim 6**, Walker et al failed to explicitly disclose the apparatus, wherein said apparatus is provided within inert packaging to allow implantation into the human body.

Mann, III et al discloses the apparatus, wherein said apparatus is provided within inert packaging to allow implantation into the human body (0042; 0051).

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Walker et al and incorporate the apparatus, wherein said apparatus is provided within inert packaging to allow implantation into the human body as taught by Mann, III et al in order to ensure adequate security.

8.   **Claim 8** is rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et at U.S. Patent Application Publication No. 2006/0218098 A1 in view of Pitroda U.S. Patent Application Publication No. 2005/0247777 A1.

As per **claim 8**, Walker et al failed to explicitly disclose the apparatus, further comprising first and second power circuits that are activated by said first and second class of terminals respectively, wherein activation of said second power circuit does not allow account information to be entered or updated in at least certain portions of said non-volatile memory.

Pitroda discloses the apparatus, further comprising first and second power circuits that are activated by said first and second class of terminals respectively,

wherein activation of said second power circuit does not allow account information to be entered or updated in at least certain portions of said non-volatile memory (see figs. 3; 0014).

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Walker et al and incorporate the apparatus, further comprising first and second power circuits that are activated by said first and second class of terminals respectively, wherein activation of said second power circuit does not allow account information to be entered or updated in at least certain portions of said non-volatile memory in view of the teachings of Pitroda in order to ensure adequate security.

9.   **Claim 24** is rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et at U.S. Patent Application Publication No. 2006/0218098 A1 in view of Sarcanin U.S. Patent Application Publication No. 2005/0246292 A1 and further in view of Wynn U.S. Patent No. RE38,137 E.

As per **claim 24**, both Walker et al and Sarcanin failed to explicitly disclose the method, further comprising making a prepayment onto the account prior to using the account for transactions.

Wynn further discloses the method, further comprising making a prepayment onto the account prior to using the account for transactions (fig. 10).

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Walker et al and incorporate the apparatus, further comprising making a prepayment onto the account prior to using the account for transactions in view of the teachings of Wynn in order to ensure adequate available credit.

10.   **Claim 27** is rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et at U.S. Patent Application Publication No. 2006/0218098 A1 in view of Wynn U.S. Patent No. RE38,137 E and further in view of Sarcanin U.S. Patent Application Publication No. 2005/0246292 A1.

As per **claim 27**, both Walker et al and Wynn failed to explicitly disclose the method, wherein the transaction record includes a digital signature from the transaction device.

Sarcanin discloses the method, wherein the transaction record includes a digital signature from the transaction device (0027; signature being generated .. using the smart card information...)

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Walker et al and incorporate the method, wherein the transaction record includes a digital signature from the transaction device in view of the teachings of Sarcanin, because such will ensure adequate transaction security

Conclusion

10.   Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.
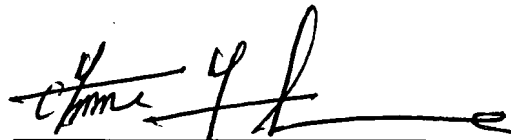
Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art ad are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of

the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Charles C.L. Agwumezie** whose number is **(571) 272-6838**. The examiner can normally be reached on Monday – Friday 8:00 am – 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Andrew Fischer** can be reached on **(571) 272 – 6779**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Charlie Lion Agwumezie
Patent Examiner
Art Unit 3621

Acc
September 11, 2007.

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